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In the Supreme Court of the United States

NO. 217

LESTER W. BAILEY,
Petitioner,

vs.

SEARS, ROEBUCK & COMPANY,
Respondent.

PETITIONER'S REPLY BRIEF ON CERTIORARI

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Respondent in its brief in opposition to the petition for certiorari says the first question of the petition is not involved in the case because the Circuit Court of Appeals held the patent void for want of invention. But the reason that court denied invention was its holding that, as a matter of law, it could not treat as evidence of invention new func-

tions and results not set forth in the patent. Respondent points out no other reason *appearing in the opinion* why the patent lacks invention. Respondent *claims* the patent lacks invention, but reference to its reasons is not found in the opinion. We think that to determine the groundwork of the opinion the Supreme Court will read the opinion itself, not respondent's arguments outside the scope of the opinion.

Alleged Contradictions. Respondent (p. 5) grasps at straws to find contradictions in the testimony on new functions and results. Dr. Cutting and Mr. Newman did testify on this subject, as respondent points out. Their testimony tends slightly to modify the effect of minimizing parallax error, and translatory motion. Mr. Bailey did not contradict what they said.

The important point is that neither Newman nor Cutting attempted to deny the *existence* of any one of these functions and results, or its *inherency* in the Bailey mechanism, or its substantial importance. If they had there would have been contradictions in the testimony.

Counsel talks as if Mr. Bailey broke down in his cross-examination on production parts. He did not. He merely gave additional information. (1 R. 318)

Neither Dr. Cutting nor Mr. Newman contradicted what he said.

Dr. Cutting's testimony relative to "ratios" to which respondent refers (Cutting, 1 R. 154) relates to the 10-1 ratio suggested by Mr. Bailey in the specification of his patent, concerning which Justice Wilbur correctly said: (III R. 508)

"The patent is not confined to this ratio."

This suggested 10-1 ratio is no more a new result than is Rysman's 12-1 ratio. The new result having to do with ratios is that in Bailey, but not other devices, the designer of the set may interpose any group of ratios he pleases between (1) the fine pointer and the condenser shaft, (2) the knob and the condenser shaft, and (3) the knob and fine pointer. (Brief Supporting Petition 16)

There is not a scintilla of testimony tending to deny the new result claimed by Bailey in the matter of ratios.

If there were no other new functions and results this one abundantly supports patentability in Bailey, *unless* the fact that it is not set out in the patent, except as inherent in the mechanism described therein, prevents its consideration on the issue of invention.

Rysman. Respondent says (p. 7) that the Rysman patent discloses:

> ". . . . the condenser rotor shaft carrying one pointer and driving (through gears and a counter shaft) another pointer on a sleeve around the shaft. In each of these main features, Rysman is exactly like Bailey."

This is wrong in two particulars. (1) Rysman's condenser shaft does not carry a pointer and (2) no sleeve surrounds that shaft.

Rysman speaks for itself both in words and in diagrams. It is not ambiguous. Dr. Cutting correctly described it. (1 R. 177)

We would stop here but there is more we think the Supreme Court should know.

The same attorneys who subscribed the above misstatements to the Supreme Court made the identical misstatements (and similar ones about the Hall patent) in their brief to the Circuit Court of Appeals where they said Rysman disclosed:

> ". . . . the condenser rotor shaft carrying one pointer and driving, through gears, another pointer on a sleeve around the shaft. In each of these main features Rysman is exactly like Bailey."

Petitioner in a brief to the Circuit Court of Appeals noted these misrepresentations, whereupon Mr. Norton sent us a copy of a letter as follows:

Copy. Norton & Simmons, 52 Vanderbilt Avenue, New York, N. Y.

September 5, 1940.

Paul P. O'Brien, Clerk,
U. S. Circuit Court of Appeals,
San Francisco, California.

Dear Sir: Re: No. 9468 Bailey vs. Sears, Roebuck

The main brief for defendant-appellee is inaccurate with respect to a part of the descriptions of the prior art patents of Hall & Rysman (pp. 18, 19), as called to our attention by plaintiff-appellant's reply brief (pp. 4, 5). The mistakes do not affect the validity of the patents as references, but we think they should be corrected as follows:

Defendant's main brief, p. 18, in the second sentence under the Hall patent, 'condenser shaft' should be changed to *sleeve,* and the following words cancelled, viz: 'rotors on one end and', 'on the other end' and 'sleeve around the'. The sentence will then read as follows: 'There is the usual tuning knob, a sleeve with a pointer, a shaft with a second pointer,'.

Defendant's main brief, p. 19, in the third sentence in the Rysman patent, 'the condenser rotor' should be cancelled and *a* substituted. The sentence will then read: 'Simply, Rysman has a clock dial, with pointers for indicating radio condenser operation, a shaft carrying one pointer and driving, through gears, another pointer on a sleeve around the shaft.'

Accordingly, will you please be so kind as to make the above corrections by interlineation in the filed briefs. We have checked with Mr. Snow, counsel for Bailey and are informed that he has no objection.

Very truly yours,

CLYDE A. NORTON
NORTON and SIMMONS

CAN:C
cc-all counsel

The correction when made leaves the passage about Rysman (and Hall) technically devoid of inaccuracy but actually uninformative. Indeed the correction was just as hurtful to petitioner as the original mistakes because of the confusion it injected into the record. The Circuit Court of Appeals was undoubtedly confused for they said, referring to Hall: (3 R. 513)

> "The fast pointer he attaches to the axis of the condenser, as is done by Rysman."

We assume that, following this brief, a similarly confusing letter will be sent to the Supreme Court.

We earnestly desire that the Supreme Court understand Rysman correctly and clearly because this patent is the groundwork of the case.

Rysman has two main shafts, e and f. Shaft e is the condenser shaft, and no pointer is attached to it. Shaft f projects through the dial and bears at its outer end the knob and the fast pointer. Bailey's condenser shaft bears his slow pointer; Rysman's condenser shaft bears none. Rysman's slow pointer is on his sleeve and is not on any shaft. Bailey's fast pointer is on his sleeve. Rysman's shafts e and f are connected by a bevel gear train whereby shaft

f turns twelve times as fast as condenser shaft e. This gear ratio is essential in Rysman's device; the bevel gears are not merely to change direction of a shaft. Rysman's shaft f and his sleeve are connected by a spur gear train by which the sleeve turns twelve times as slow as shaft f. The sleeve bears the slow pointer. Such features are not found in Bailey. Shaft f which projects through Rysman's dial bears his knob as well as his fast pointer. Such a feature is not found in Bailey.

The fact that the Bailey mechanism had the same general object as those of Rysman, Hall, and Siemens-Halske cannot prevent patenability. It might be possible to have several valid patents for different kinds of airplane wing construction all aimed at the same general purpose—better flying.

Mr. Bailey does not claim to have invented gears, either step up or step down. The elements of his combination are not new. Some of them appear in Rysman. The newness in Bailey's combination lies in his new design and new arrangement of these elements rather than in the invention of new elements themselves.

We would have to concede want of patentability if Bailey's new arrangement did not function differently and produce new results, or if such new functions and results could not be considered because they are not set out in the patent.

But the new functions and results are established by testimony as inherent in the Bailey structure. The question upon which certiorari is asked is whether the court must, under the law, ignore them because they are not recited in the patent.

Respectfully submitted,

JOHN F. REILLY,
MacCORMAC SNOW,
Attorneys for Petitioner.